

REMARKS

Applicants have amended their claims in order to further clarify the definition of various aspects of the present invention. Specifically, Applicants have canceled previously considered claims 1-13, and have added new claims 14-20 to the application. Of these newly added claims, claim 14 is the sole independent claim. All of the newly added claims are directed to an extruded frame member for use in friction stir welding.

Claim 14 recites that the extruded frame member includes at least one plate, with at least one end portion of a width of this at least one plate being provided respectively with a thickened part which protrudes from a side of the at least one plate, in a thickness direction of such plate; claim 14 recites that the extruded frame member further includes an extruded part extending from the thickened part, substantially in parallel to the at least one plate of the extruded frame member, and extending beyond the at least one end portion of the width of the at least one plate, in a direction of the width of the at least one plate. In connection with claim 14, note, for example, Figs. 17 and 18, together with the description from page 22, line 24 to page 25, line 11, of Applicants' specification. Claim 15, dependent on claim 14, recites that a triangular-shaped groove is formed between an outer surface of the thickened part and an outer surface of the extruded part. Note, for example, Fig. 18, together with the description at page 25, lines 5-11 of Applicants' specification. Claims 16 and 17, each dependent on claim 14, respectively recites that the extruded part is positioned at a side end of the thickened part; and recites that the at least one plate of the extruded frame member, the thickened part and the extruded part are formed integrally as one body. See Fig. 18. Claim 18, dependent on claim

14, recites that an outer surface of the thickened part and an outer surface of the extruded part are coplanar. Claims 19 and 20, dependent respectively on claims 14 and 19, respectively recites that at an end side of the at least one plate of the extruded frame member and under the extruded part, at least one plate of another extruded frame member is adapted to be positioned, with the end side of the at least one plate of the extruded frame member adapted to be abutted to an end side of the at least one plate of the another extruded frame member, for carrying out a friction stir welding of the extruded frame member and the another extruded frame member; and recites that during this friction stir welding, material of the thickened part and of the extruded part is adapted to fill up any gaps, between the respective plates of the extruded and another extruded frame member, which exist when the extruded frame member abuts the another extruded frame member. See, for example, Fig. 18.

Note also the aforementioned portions of pages 22-25 of Applicants' specification.

Initially, Applicants respectfully request reconsideration and withdrawal of the finality of the Office Action mailed August 2, 2002. In this regard, Applicants note, for example, the rejection of claim 2 under the second paragraph of 35 USC 112, as set forth in Item 9 on pages 3 and 4 of the Office Action mailed August 2, 2002.

Note that this rejection of claim 2 is based on the allegation by the Examiner that "a face of one side of the plate, at at least one end portion of the width of the extruded frame member", in claim 2, is vague and indefinite. However, note that this language objected to by the Examiner in the Office Action mailed August 2, 2002, was in original claim 2, and that original claim 2 was not rejected under the second paragraph of 35 USC 112, in the Office Action mailed February 13, 2002. That is, at least for the reason that the Examiner has presented a new rejection of claim 2 in

the Office Action mailed August 2, 2002, which was not necessitated by Applicants' amendments to their claims in the Amendment filed May 13, 2002, the finality of the Office Action mailed August 2, 2002, is clearly improper. See Manual of Patent Examining Procedure 706.07(a), stating that under present practice, a second or any subsequent action on the merits shall be final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..."

The contention by the Examiner in Item 15 on page 8 of the Office Action mailed August 2, 2002, that Applicants' Amendment filed May 13, 2002 necessitated the new grounds of rejection presented in the Office Action mailed August 2, 2002, is respectfully traversed. Clearly, Applicants' amendments did not necessitate at least the new grounds of rejection of claim 2, where language in original claim 2 is rejected for the first time in the Office Action mailed August 2, 2002.

In any event, it is respectfully requested that the present amendments be entered. Noting, for example, the various new grounds of rejection, and new objections to the drawings and to the Amendment filed May 13, 2002, in the Office Action mailed August 2, 2002, it is respectfully submitted that the present amendments materially limit issues remaining in connection with the above-identified application; and, at the very least, present the claims in better form for appeal. Furthermore, noting Figs. 17-19 of Applicants' original disclosure and the pertinent portions of Applicants' specification on pages 22-25, previously referred to herein, it is respectfully submitted that the present amendments raise no new issues, including any issue of new matter. Clearly, noting the new objections and rejections

set forth in the Office Action mailed August 2, 2002, the present amendments are timely.

In view of the foregoing, it is respectfully submitted that Applicants have made the necessary showing under 37 CFR 1.116(c); and that, accordingly, entry of the present amendments is clearly proper.

Applicants respectfully traverse the objection to their drawings, as set forth in Item 4 on page 2 of the Office Action mailed August 2, 2002, insofar as this objection is applicable to the present claims. Thus, note that the present claims recite a width of the at least one plate; however, attention is respectfully directed to Fig. 17 of Applicants' disclosure, showing extruded frame members 150, with Fig. 18 showing a cross-section of an end portion of an extruded frame member 150, having plate 151. It is respectfully submitted that Fig. 17, for example, with Fig. 18, shows the width of the plate. Moreover, it is respectfully submitted that Fig. 17 shows the direction of width of the plate. Other phrases in the claims objected to by the Examiner have been deleted, such that objections to the drawings with respect to such other phrases in the claims are moot.

The objection to the Amendment filed May 13, 2002, set forth in Item 5 on pages 2 and 3 of the Office Action mailed August 2, 2002, is respectfully traversed, particularly insofar as applicable to the claims as presently amended. In the following, specific structure in Applicants' original disclosure will be pointed to as illustrating the present invention; as can be appreciated, the present invention is not limited to this specific structure. This specific structure only illustrates what Applicants contemplated as an aspect of their invention. It is respectfully submitted that Applicants' disclosure clearly shows a plate (151) having a width (see Fig. 17),

with at least one end portion of this width being provided with a thickened part (156) which protrudes in a thickness direction, and the extruded frame member further including an extruded part (157) extending from the thickened part, and extending as set forth in the present claims. Noting particularly Fig. 18 together with Fig. 17, and also with the description on pages 22-25 of Applicants' specification as referred to previously, it is respectfully submitted that the disclosure is clear with respect to the extruded frame member 150 and width thereof and of a plate thereof, and a thickened part (156) extending in a thickness direction of the plate of the extruded frame member, with extruded part 157 extending beyond the end of the plate 151 in the width direction. Clearly, the original disclosure of the above-identified application describes the extruded part extending beyond the at least one end portion of the plate (151), in a direction of the width, such that this recitation does not constitute new matter within the meaning of 35 USC 132.

Applicants respectfully traverse the rejection of their claims under the first paragraph of 35 USC 112, insofar as this rejection is applicable to the claims presently in the application. As indicated previously, the width of the at least one plate is clearly shown in, for example, Fig. 17; especially when taking Fig. 17 together with Fig. 18, it is respectfully submitted that Applicants' disclosure as originally filed clearly shows the plate having a width and the thickened part and extruded part as recited in the present claims. Recitations of a length and of an extruded direction have been omitted from the present claims; in view of the present claims and foregoing explanation, it is respectfully submitted that the rejection under the first paragraph of 35 USC 112 is seen to be clearly improper, particularly with respect to the present claims.

The question raised by the Examiner in Item 7 on page 3 of the Office Action mailed August 2, 2002, as to what is a width direction, is noted. It is respectfully submitted that the "width" is recited as the "width" of the at least one plate of said extruded frame member. It is respectfully submitted that such width direction is clearly seen in Fig. 17, and in the description in the paragraph bridging pages 22 and 23 of Applicants' specification. With respect to the description in Applicants' specification, note that in the paragraph bridging pages 22 and 23, and in the first full paragraph on page 23, Applicants' specification refers to "lengths" of the extruded frame members 150 and of the extruded frame members 160 extending in directions orthogonal to each other, with the extruded frame members 150 having their lengths extending in the same direction. It is respectfully submitted that this description further indicates the width, consistent with the recitation in the present claims.

Applicants respectfully traverse the rejection of their claims under the second paragraph of 35 USC 112, as being indefinite, set forth in Item 9 bridging pages 3-5 of the Office Action mailed August 2, 2002, particularly insofar as this rejection is applicable to the present claims. Especially in light of, for example, Figs. 17 and 18 of Applicants' original disclosure, particularly together with the description on pages 22-25 of Applicants' original disclosure, the metes and bounds of the present invention are sufficiently definitely set forth, so as to satisfy applicable requirements of 35 USC 112, second paragraph. Thus, as seen in Fig. 18, plate 151 of extruded frame member 150 is shown, with thickened part 156 at one end portion of a width (see Fig. 17) of the plate. As clearly seen in Fig. 18, the thickened part (156) protrudes from a side of the at least one plate, in a direction of thickness of the at

least one plate, and the extruded frame member further has an extruded part (157) extending from the thickened part (156), substantially in parallel with the at least one plate of the extruded frame member and extending beyond the at least one end portion of the extruded frame member in a direction of the width of the plate.

The recitations which the Examiner considers to be vague and indefinite, set forth in the first paragraph on page 4 of the Office Action mailed August 2, 2002, are noted. As can be seen particularly in Fig. 18, the thickness direction of the plate, and the extending of the extruded part beyond the at least one end portion of the width, in a direction of the width (note Fig. 17, in particular, for the width), are sufficiently definite to satisfy the requirements of the second paragraph of 35 USC 112. Moreover, as seen in Fig. 18, the extruded part extends substantially in parallel to the plate, and sufficiently defines positioning of the extruded part so as to satisfy the requirements of the second paragraph of 35 USC 112.

It is noted that claim 15 defines a triangular-shaped groove formed between an outer surface of the thickened part and an outer surface of the extruded part. See, for example, the groove referenced by reference character 158 in Fig. 18, for example. It is respectfully submitted that this recitation in connection with the triangular-shaped groove sufficiently defines the metes and bounds of this aspect of the present invention, so as to satisfy applicable requirements of the second paragraph of 35 USC 112.

As can be seen from the foregoing, as well as by a comparison of the present claims with the previously considered claims, the present claims have been extensively amended in comparison with previously considered claims so as to overcome issues raised by the Examiner in connection with 35 USC 112, including

the second paragraph of 35 USC 112. If any issues remain that can be overcome by an Interview, the Examiner is respectfully requested to contact the undersigned for conducting an Interview to overcome any remaining issues. The Examiner is thanked in advance for complying with this request, if necessary.

Applicants respectfully traverse the rejection of their claims on prior art grounds, over the teachings of U.S. Patent No. 6,354,483 to Ezumi, et al. Thus, note that the U.S. patent to Ezumi, et al., No. 6,354,483, has a prior art date under 35 USC 102(e) of August 23, 2000. In contrast, the above-identified application claims priority under 35 USC 120 of prior application Serial No. 09/025,070, filed February 17, 1998. Applicants have amended the first page of their specification to identify No. 09/025,070, as required by 35 USC 120. Note the Preliminary Amendment filed April 10, 2001, in the above-identified application. Accordingly, the above-identified application has an effective filing date of February 17, 1998, prior to the prior art date under 35 USC 102(e) of Ezumi, et al. Accordingly, clearly U.S. Patent No. 6,354,483 does not constitute prior art in connection with the above-identified application. Reconsideration and withdrawal of the U.S. patent to Ezumi, et al. as prior art is respectfully requested.

Since Ezumi, et al. clearly does not constitute prior art in connection with the presently claimed subject matter, and cannot form the basis of a rejection under 35 USC 102(e), no further discussion of this U.S. patent is necessary. Suffice it to say that Applicants do not agree with the merits of the prior art rejection set forth in the Office Action mailed August 2, 2002, and do not agree with contentions made by the Examiner in connection therewith.

In view of the foregoing comments and amendments, reconsideration and

withdrawal of the finality of the Office Action mailed August 2, 2002, and, after entry of the present amendments, reconsideration and allowance of all claims then in the application, are respectfully requested.

In any event, entry of the present amendments, and reconsideration and allowance of all claims in the application, are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 503.35933VV5) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "William I. Solomon", with a long horizontal flourish extending to the right.

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